

REMARKS

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

The applicant requests:

- (1) that the "Notification of Non-Compliance With 37 CFR 1.192(c)" mailed 10/21/2003 be VACATED and
- (2) that the appeal brief originally filed April 29, 2003 and re-filed September 25, 2003 be considered on appeal.

II. STATEMENT OF MATERIAL FACTS

1. The applicant filed an amendment after final and 37 CFR 1.132 declaration on April 25, 2003 and re-filed the amendment after final on September 25, 2003.
2. The amendment after final amends claim 36 and adds new claims 57 and 58. The amendment has not been entered.
3. The applicant filed an appeal brief under 1.192(b)(2)(ii) on April 25, 2003, and re-filed the same brief on September 25, 2003.
4. The April 25, 2003 appeal brief contains a 37 CFR 1.192(c)(9) appendix showing all claims under appeal as they stood assuming the amendment after final was not entered.
5. The April 25, 2003 appeal brief contains a second 37 CFR 1.192(c)(9) appendix showing all claims under appeal as they would stand if the amendment after final was entered.
6. The April 25, 2003 appeal brief contains a third appendix showing all claims as they would stand if the amendment after final is entered.
7. The applicant previously filed a paper in response to the notice. As of 1/5/2004, the applicant has not received a response to that paper. That paper stated in part:

The office communication mailed 10/21/2003 is a form "Notification of Non-Compliance with 37 CFR 1.192(c). The notification states that, "To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) ... [within the applicable time period.] The form contains 9 check boxes adjacent to reasons for non-compliance. Only box number 9 is checked. Box number 9 states "Other including any explanation in support of the above item):" Below box 9, the examiner typed the following:

The appeal brief filed 29 April 2003 is not acceptable under 37 CFR 1.191(a) because claim 38 is amended *and there has been no second rejection for claim 38 in this patent application.* [Italics supplied for emphasis.]

In reply, the applicant takes the following two actions.

First, the applicant is complying with the requirement "in order to avoid abandonment." the revised brief is being filed in triplicate and includes in its appendix the version of claim 36 without any amendment. Accordingly, the application should not be held abandoned.

Second, the applicant requests reconsideration and withdrawal of the holding of non-compliance and reinstatement of the appeal brief filed April 29, 2003 (and subsequently re-filed September 25, 2003 as a result of the USPTO losing the initial filing.) This is because the holding of non-compliance of the appeal brief filed April 29, 2003 is improper, not in accordance with rule, statute, or case law, for the reasons explained below. Moreover, if the April 29, 2003 the examiner does not reinstate the appeal brief and provide good reason why that action is proper by 12/23/2003, the undersigned will petition the Commissioner on 12/23/2003 for that action. The argument below is presented in the format for a petition, for convenience.

III. STATEMENT OF THE REASON WHY THE RELIEF REQUESTED SHOULD BE GRANTED

The holding of non-compliance of the brief filed April 29, 2003 is based upon the examiner's assertion that the "appeal brief filed 29 April 2003 is not acceptable under 37 CFR 1.191(a) because claim 38 is amended and there has been no second rejection for claim 38 in this patent application.." The examiner's implication is that 37 CFR 1.191(a) prevents an appeal when a claim, as amended, has not been twice rejected. The examiner's legal conclusion is based upon an improper and ultra vires reading of 37 CFR 1.191(a). The examiner's action is not in accordance with binding precedent of the Board construing the applicant's right of appeal provided by 35 USC 134(a). 35 USC 134(a) provides an applicant a right of appeal when any of the applicant's claims have been twice rejected, stating that:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

37 CFR 1.191(a) parallels the statutory right, stating in pertinent part that:

Every applicant for a patent ... any of whose claims has been twice or finally (37 CFR 1.113) rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences ...

Moreover, in Ex parte Lemoine, an expanded panel of the Board construed 35 USC 134(a) to mean that an applicant has a right of appeal whenever the applicant's claim *to a patent* is twice or more rejected, not whenever any particular claim, amended or otherwise, is twice or more rejected, stating that:

Considering these sections together, we conclude that "claims" as used in §134 is a reference to the repeated "claim for a patent" as used in §132 rather than a reference to a particular claim "of an application." Under our interpretation, so long as the applicant has twice been denied a patent, an appeal may be filed. So construing the statute, we conclude that applicant's claims for a patent have been twice rejected. Applicant has been denied a patent three times. Applicant, therefore, had the right to appeal and we, accordingly, have jurisdiction. [Ex parte Lemoine, 46 USPQ2d 1420, ____ (PTOBPAI 1994)(*precedential decision* of an expanded panel including APJ Schafer, APJ Meister, SAPJ McKelvey, and CAPJ Stoner)]

Thus, any requirement based upon an interpretation of 37 CFR 1.191(a) limiting the right of appeal to claims that are twice rejected is inconsistent with the statute as interpreted in a binding precedential opinion of the Board. Accordingly, the basis for the Notification of non-compliance, which is that the amendment to claim 36 is not in compliance with 37 CFR 1.191(a) is inconsistent with the applicant's rights specified in 35 USC 134(a) and therefore improper and must be withdrawn.

As an aside, I note that the form notice mailed 10/21/2003 to the applicant is a notice of non-compliance "With 37 CFR 1.192(c)," not with 37 CFR 1.191(a), and it is 37 CFR 1.191(a) that is the basis of the examiner's notice and requirement to comply. The notice specifies no basis under 37 CFR 1.192(c), so I must presume that this particular form was used because the examiner did not have access to a form whose title included "37 CFR 1.191(a)". Specifically, the examiner did not object to the second and third appendices in the appeal brief, which could relate to 37 CFR 1.192(c). In any case, there is no section of 37 CFR 1.192(c) that specifies that an amended claim is improper. For all of the foregoing reasons, the notice and requirement to comply are improper and should be withdrawn and the appeal brief filed April 29, 2003 should be reinstated.

Respectfully Submitted,

Date

1/5/04

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